UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/575,500 | 04/11/2006 | Xing Zhou | SCI.PAU.01.US | 3932 |

23386 7590 05/03/2010

Myers Andras Sherman LLP
19900 MacArthur Blvd.
Suite 1150
Irvine, CA 92612

| EXAMINER | |
|---|---|
| EASTWOOD, DAVID C | |
| ART UNIT | PAPER NUMBER |
| 3731 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/03/2010 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
|---|---|---|---|
| | *10/575,500* | ZHOU ET AL. | |
| | Examiner | Art Unit | |
| | David Eastwood | 3731 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 12 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-11 and 13-20*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731

/D. E./
Examiner, Art Unit 3731
4/27/2010

Continuation of 11. does NOT place the application in condition for allowance because: Applicant proffers that Conlon fails to disclose "the string opens the specimen pouch when heated" as required by claims 1, 15 and 19. The Examiner respectfully disagrees with applicant's assessment of the prior art of record. The temperature of the string is irrelevant to its ability to perform the function of opening the specimen bag as disclosed by Conlon et al. When heated to their expansion temperature nitinol spring arms 47 (C4 L44-47) will begin to apply opening pressure to the rim of open end 76, release of string 95 frees the spring arms to expand thus opening the bag when heated. The string of Conlon would be capable of opening the specimen bag when heated or cooled so long as the aforementioned spring arms are providing expanding pressure to the specimen bag. As to the argument that the string only allows the bag to open and does not actually open the bag it is the Examiners interpretation that if the bag is in a state in which the spring arms are applying expanding pressure to the bag, the bag will not open until the string is released thus opening the bag. Applicant Further proffers that Conlon fails to disclose a specimen bag having discontinuous serrations where on said serrations there are slots through which a string can pass in claim 1 and channels through which a deployment and retrieval string can pass in claims 15 and 19. The Examiner again respectfully disagrees with applicants assertions. Conlon discloses said flexible wall of the open end of the specimen pouch has discontinuous serration (when the bag is in a closed state buckle points 85,86 buckle intermittently forming serrations see also C7 L43-50); on said serration, there are slots (opening above serrations encapsulating string 95) through which a string can pass. The plain meaning of the term serration or serrate is notched on the edge like a saw, serrate. (n.d.). Dictionary.com Unabridged. Retrieved April 27, 2010, from Dictionary.com website: http://dictionary.reference.com/browse/serrate. Therefore when discontinuous weld lines 85, 86 buckle they form a notched zig-zag saw tooth pattern with intermittent bends which fits the definition of a serrate pattern or serration note C7 L43-50. With respect to the slot or channel through which a string can pass Conlon clearly discloses slots or channels formed by the intermittently buckling points in which string (95, 96) is encapsulated note description of string and weld lines disclosed in C7 L7-33 and depicted in fig. 8. Applicant further alleges that the Device of Conlon would be incapable of being used in micro invasive surgery due to its contracted pouch size. With regard to Applicants allegation Applicant has provided no evidence to establish an unobvious difference between the claimed product and the prior art, but rather has merely argued such alleged difference. Mere arguments can not take the place of evidence. In re Walters, 168 F.2d 79,80, 77 USPQ 609,610 (CCPA 1948); In re Cole, 326 F.2d. 769,773, 140 USPQ 230,233 (CCPA 1964); In re Schulze, 346 F.2d 600,602, 145 USPQ 716,718 (CCPA 1965); In re Lindner, 457 F.2d 506,508, 173 USPQ 356,358 (CCPA 1972); In re Pearson, 494 F.2d 1399,1405, 181 USPQ 641,646 (CCPA 1974); Meitzner v. Mindick, 549 F.2d 775,782, 193 USPQ 17,22 (CCPA), cert. Denied, 434 U.S. 854 (1977); In re DeBlauwe, 736 F.2d 699,705, 222 USPQ 191,196 (Fed. Cir. 1984). Regarding Applicants arguments directed to claims 2-5, 16-18 and 20, the Examiner notes Applicant's piecemeal analysis of the references, one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. Applicant states that Cope does not disclose a device which opens upon being exposed to body temperature alleging that Cope teaches away from this. The examiner disagrees, Cope discloses that the device is above transformation temperature (open state) when in OPERATING CONDITION (C 2 L 61). The examiner is interpreting this operating condition as being in vivo at body temperature, approx. 98.6 deg. Fahrenheit, while room temperature is well below this thus capable of being below the transformation temperature in which the basket would be in a contracted non-expanded state. In light of this interpretation Cope discloses a basket which opens upon being exposed to body temperature. With regard to Applicants allegation that the Examiner failed to establish a prima facie case of obviousness It is noted that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale to modify may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). With regard to Applicants statements regarding the combination of Conlon and Matey. Applicant confirms that Matey marks a surgical device such that it can be distinguished from the internal anatomy p. 22 of applicant's response filed 2/12/2010. Therefore, one of ordinary skill in the art would have been capable of applying this known technique, distinctly marking the device such that it differs from a biological specimen, to a known device, the specimen pouch of Conlon, that was ready for improvement and the results would have been predictable to one of ordinary skill in the art. Furthermore it is noted that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale to modify may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)